

1 The opinion in support of the decision being entered today was *not* written
2 for publication and is *not* binding precedent of the Board
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4 UNITED STATES PATENT AND TRADEMARK OFFICE
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6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
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11 *Ex parte* DAVID K. McKNIGHT and EDUARDUS A.T. MERKS
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14 Appeal 2006-2818
15 Application 09/489,793
16 Technology Center 2100
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19 Decided: February 27, 2007
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22 *Before:* ANITA PELLMAN GROSS, ROBERT E. NAPPI, and
23 ANTON W. FETTING, *Administrative Patent Judges.*
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25 NAPPI, *Administrative Patent Judge.*
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28 ORDER REMANDING TO THE EXAMINER
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30 This is a remand to the Examiner pursuant to 37 CFR § 41.50(a)(1)
31 (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004)).
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STATEMENT OF CASE

This case comes before us for a decision on appeal under 35 U.S.C. § 134 of the rejection of claims 1 through 13, 16 through 22, 24 through 36, and 40 through 43. The Examiner has indicated that claim 23 contains allowable subject matter.

From our review of the record, we find that the application is not in condition for decision on appeal for the reasons which follow. Accordingly, we remand the application to the Examiner to take appropriate action.

The Examiner has rejected claims 1 through 13 and 40 through 43 under 35 U.S.C. § 101.

The Examiner has rejected claims 1 through 13, 16 through 22, 24 through 36, and 40 through 43 under 35 U.S.C. § 103(a).

Claims 8 through 11, 21 and 31 through 34 are multiple dependent claims which depend upon other multiple dependent claims. Therefore, these claims are improper (See 37 C.F.R. § 1.75 (c) and MPEP 608.01(n)), as the scope of the claims is indeterminate. However, the Examiner has considered the claims as being proper and has applied art to them in his rejections. We remand this case for the Examiner to require that the Appellants place the claims in proper form (we note that Office policy is for the Examiner to object to the improper claims and require that they be canceled as set forth in MPEP 608.01(n)).

The Examiner's rejection of claims 1 through 13 and 40 through 43 under 35 U.S.C. § 101 states "each of said claims can be fairly interpreted as a series of mental and/or manual steps (i.e. mentally/manually manipulating,

1 formatting, parsing printed documents, etc.), and is therefore directed to
2 non-statutory subject matter.” (Answer, page 3), While the claims may in
3 fact be directed to non-statutory subject matter, the Examiner’s rejection
4 does not follow the analysis set forth in the *Interim Guidelines for*
5 *Examination of Patent Applications for Patent Subject Matter Eligibility*,
6 1300 Off. Gaz. Patent and Trademark Off. (O.G.) 142, 152 (Nov. 22, 2005).

7 This document is located at the following URL:

8 [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelin](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)
9 [es101_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)

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11 We encourage the Examiner to apply the analysis set forth in the Interim
12 Guidelines to support the rejection under 35 U.S.C. § 101.

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14 Thus, we REMAND the application to the Examiner to clarify the
15 issues noted *supra*. The Examiner may comply with this remand either by a
16 supplemental examiner's answer responsive to the above-noted issues or, if
17 appropriate, by re-opening prosecution to address the above noted issues. It
18 follows that Appellants should have an opportunity to respond to any such
19 supplemental answer by way of a further reply brief or via other action as
20 provided in 37 CFR § 41.50(a)(2).

21 This remand to the Examiner pursuant to 37 CFR § 41.50(a)(1)
22 (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286
23 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further
24 consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a
25 supplemental Examiner's answer is written in response to this remand by the
26 Board.

